

THE OFFICE ACTION

In the Office Action mailed March 29, 2005, the drawings stand objected to under 37 CFR §1.83(a).

Claims 1-11 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

In the Examiner's Response to Arguments of the Office Action mailed March 29, 2005, the Examiner withdrew the prior rejection of claim 1, and acknowledged that an updated search failed to locate any references that would allow the Examiner to apply a prior art rejection. However, upon further consideration of Applicant's disclosure, the above-described new grounds of rejection were applied based on the Microsoft Press Computer Dictionary definition of module.

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of March 29, 2005.

Reconsideration of the Application is requested in light of the above amendments and following comments. Claims 1-11 remain in this application.

A. Summary of Telephone Conference

A brief telephone conference was conducted with the Examiner on July 12, 2005 at 10:00 a.m. The use of the word "module" as recited in amended claims 1 and 7 was the primary subject matter of the conference. In particular, claim 1 recites limitations using a contact module, a determining module, a downloading and installing module, and an uninstalling module. Claim 7 also recites limitations for each of a contact module, a determining module, a comparing module, a downloading and installing module, and an uninstalling module.

Applicant suggested substituting the word "subroutine" in place of the word "module" in the subject claim for the following reasons. As pointed out by the Examiner, the specification describes one embodiment of the update program as a module, and does not describe the update program as being built of other modules. Also, by definition, a module itself cannot contain another module as also pointed out in the Office Action. The present

application does, however, use the word subroutine in describing the contacting, determining, comparing, downloading, installing, and uninstalling functions. And, by definition, a module may be built of multiple routines, subroutines, or subprograms, and the use of the word subroutine would not only more accurately describe the subject limitations in claims 1 and 7, as amended, but also have sufficient support in the specification and drawings. It is Applicant's understanding that the Examiner agrees with the appropriateness of the suggested substitution.

The drawings were also objected to in the above-referenced Office Action for not showing the contact module, comparing module, determining module, downloading and installing module, and uninstalling module. Applicant suggested that the above-described substitution should be sufficient to obtain withdrawal of the objection to the drawings under 37 CFR §1.83(a). The specification describes the functions recited in claims 1 and 7, as amended, and FIG. 4 of the present application shows each of the cited functions in the form of a flowchart. It is Applicant's understanding that the Examiner also agrees that there is sufficient showing in the drawings if the suggested substitution is amended into the claims.

B. Amended Claim 1 complies with §112

Claim 1 was rejected in the subject Office Action under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, it is stated in the Office Action that the contact module, the determining module, the downloading and installing module, the uninstall module, and their functions are subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant has amended claim 1, substituting each occurrence of the word "module" with the word "subroutine." Applicant respectfully submits that the use of the word "module" was an inadvertently inappropriate choice of words in view a strict interpretation of the word as used in the art, and in view of the fact that the specification describes the respective procedures as subroutines. For example, page 7, lines 1-6 of the present application describes a program subroutine which automatically attempts to update a printer driver, and further describes one embodiment of the program subroutine as a module. The

contacting, determining, downloading and installing, and uninstalling procedures are clearly set forth in the specification from page 7, line 9 through page 9, line 13, and are shown in FIG. 4 for one embodiment. Of course, it is well known in the art that modules or subroutines such as the described program subroutine or module are commonly constructed of a collection of functions, subprograms, or subroutines. It would be common practice to implement each of the described contacting, determining, downloading and installing, and uninstalling procedures as respective subroutines of the update program or module.

Applicant submits that each of the recited subroutine limitations in claim 1, as amended, is clearly described in a way to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention at the time the application was filed. Applicant, therefore, respectfully requests withdrawal of this rejection of claim 1, and also claims 2-6 depending therefrom.

C. Amended Claim 7 complies with §112

Claim 7 was similarly rejected in the subject Office Action under 35 U.S.C. §112, first paragraph. Specifically, it is stated in the Office Action that the contact module, the determining module, the downloading and installing module, the uninstall module, the comparing module, and their functions are subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant has also amended claim 7, substituting each occurrence of the word "module" with the word "subroutine." Applicant notes that the comparing subroutine recited in amended claim 7 is described on page 8, lines 7-10, and shown as step 50 in FIG. 4. For the same reasons as set forth with respect to claim 1, Applicant submits that each of the recited subroutine limitations in claim 7, as amended, is clearly described in a way to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention at the time the application was filed. Applicant, therefore, respectfully requests withdrawal of this rejection of claim 7 and claims 8-11 depending therefrom.

D. Drawings comply with 37 CFR §1.83(a)

The drawings were objected to in the subject Office Action as failing to comply with

37 CFR §1.83(a). Specifically, it is stated that the contacting module, the comparing module, the determining module, the downloading and installing module, and the uninstall module must be shown or the features canceled from the claims. Applicant has amended each of the module limitations in the claims to recite, instead, a subroutine limitation. Each of the subroutines recited in the claims is shown in FIG. 4 of the present application. Specifically, the contacting subroutine 44, the comparing subroutine 50, the determining subroutine 46-48, the downloading and installing subroutine 52-54, and the uninstall subroutine 54 are shown in the figure. Applicant, therefore, respectfully requests withdrawal of this objection.

CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-11) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment B. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark Svat, at Telephone Number (216) 861-5582.

Respectfully submitted,

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7/28/05

Date



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